

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Re: Appeal to the Board of Patent Appeals and Interferences

In re PATENT APPLICATION of  
Inventor(s): GIROUARD et al.  
Appln. No.: 09

472,134  
Serial No. ↑

Group Art Unit: 3618  
Examiner.: Ann Marie Boehler  
Atty. Dkt. P 86169  
M# RP-00066-US3  
Client Ref

Filed: December 23, 1999  
Title: SNOWMOBILE

Mail Stop Appeal Brief-Patents  
Hon. Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450



Date: May 27, 2003

RECEIVED  
MAY 30 2003  
GROUP 3600

Sir:

1. ☐ **NOTICE OF APPEAL:** Applicant hereby appeals to the Board of Patent Appeals and Interferences from the decision (not Advisory Action) dated \_\_\_\_\_ of the Examiner twice/finally rejecting claim(s) in this application or in this application and its parent application.
2. ☒ **BRIEF** on appeal in this application attached in triplicate (extendable up to 5 months).
3. ☐ An **ORAL HEARING** is respectfully requested under Rule 194 (due two months after Examiner's Answer- unextendable)
4. ☐ Reply Brief is attached in triplicate (due two months after Examiner's Answer - unextendable).
5. ☐ "Small entity" statement filed: ☐ herewith. ☐ previously.
6. ☐ Fee NOT required because paid in prior appeal in which the Board of Patent Appeals and Interferences did not render a decision on the merits (35 USC 134).

7. FEE CALCULATION

	Large/Small Entity	Fee Code
If box 1 above is X'd, ..... enter	\$320/160	\$0 119/219
If box 2 above is X'd, ..... enter	\$320/160	\$320 120/220
If box 3 above is X'd, ..... enter	\$280/140	\$0 121/221
If box 4 above is X'd, ..... enter nothing	- 0 - (no fee)	
8. Original due date: January 25, 2003		
9. Petition is hereby made to extend the original due date (1 mo) \$110/\$55		115/215
to cover the date this response is filed for which the (2 mos) \$410/\$205		116/216
(3 mos) \$930/\$465		117/217
(4 mos) \$1,450/\$725		118/218
(Usable only if box 2 is X'd--- 5 mos) \$1,970/\$985	+\$1450	128/228
10. Enter any previous extension fee paid <input checked="" type="checkbox"/> previously since above		
Original due date (item 8); <input type="checkbox"/> with concurrently filed amendment .....	-\$930	
11. Subtract line 10 from line 9 and enter: Total Extension Fee		+\$520
12. TOTAL FEE =		\$840

PLEASE CHARGE  
OUR DEP. ACCT.

(Our Deposit Account No. 03-3975)

06/23/2003 EHARRIS 00000001 033975 09472134

(Our Order No. 86169

C#

M# 265136

01 FC:1254 930.00 DA

**CHARGE STATEMENT:** The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficiencies only) now or hereafter relative to this application and the resulting Official Document under Rule 20, or credit any overpayment, to our Accounting/Order Nos. shown above, for which purpose a duplicate copy of this sheet is attached. This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal sheet is filed.

05/29/2003 AWONDAF1 00000002 033975 09472134

02 FC:1254 520.00 CH

Pillsbury Winthrop LLP  
Intellectual Property Group

P.O. Box 10500  
McLean, VA 22102  
Tel: (703) 905-2000

By: Atty: Caroline D. Dennison

Reg. No. 34494

Atty/Sec: CDD/tam

Sig: Caroline D. Dennison

Fax: (703) 905-2500

Tel: (703) 905-2047

NOTE: File this cover sheet in duplicate with PTO receipt (PAT-103A) and attachments

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re PATENT APPLICATION OF

GIROUARD et al.

Appln. No.: 09/472,134

Filed: December 23, 1999

Title: SNOWMOBILE

Confirmation No.: 8367

Group Art Unit: 3618

Examiner: Anne Marie Boehler



May 27, 2003

\* \* \* \* \*

**APPEAL BRIEF**

Hon. Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Submitted by:

**PILLSBURY WINTHROP LLP**  
Attorneys for Appellants

Caroline D. Dennison  
Reg. No. 34,494

Jeffrey D. Karceski  
Reg. No. 35,914

Paul T. Bowen  
Reg. No. 38,009

## TABLE OF CONTENTS

I.	INTRODUCTION .....	1
A.	Real Party in Interest.....	1
B.	Statement of Related Appeals and Interferences .....	1
C.	Status of Claims .....	2
D.	Status of Amendments .....	2
II.	SUMMARY OF THE INVENTION .....	2
III.	ISSUES .....	4
IV.	GROUPING OF CLAIMS.....	5
V.	ARGUMENT.....	6
VI.	CONCLUSION.....	20
VII.	APPENDIX A – PENDING CLAIMS .....	22
VIII.	APPENDIX B .....	46

I. INTRODUCTION

This Brief presents authorities and arguments that Appellants are relying upon to maintain the appeal of the Examiner's November 14, 2002, final rejection of claims 1-49, 55, 57-61, 64-68, 73 and 77-92.



A. Real Party in Interest

The real party in interest for this Appeal and the present application is Bombardier Inc. An Assignment of this application to Bombardier Inc. was recorded in the U.S. Patent and Trademark Office on May 18, 2000, at Reel/Frame 010829/0058.

B. Statement of Related Appeals and Interferences

This Application is the parent of U.S. Application Serial No. 09/877,188 filed June 11, 2001, also owned by Bombardier Inc. A notice of appeal was filed in Serial No. 09/877,188 on May 1, 2003. The related appeal is directed to different aspects of this inventive concept, and appeals rejections based on different issues. Therefore, the outcome of the appeal in Serial No. 09/877,188 should not directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

As these appeals are related to the same overall inventive concept, for purposes of efficiency and enhanced understanding, Appellants intend to file motions at the appropriate time for oral hearings in these two appeals to be scheduled consecutively and for the introduction of exhibits during each oral hearing. Appellants intend to present a prior art vehicle and a vehicle designed in accordance with this invention as an exhibit.

C. Status of Claims

Claims 1-49, 55, 57-60, 64-68, 73, 77-88, 90 and 92 are pending, all of which stand rejected and are the subject of this appeal<sup>1</sup>. Claims 50-54, 56, 61-63, 69-72, 74-76, 89, and 91 have been canceled. A copy of the claims as they presently stand is attached as Appendix A in Section VII.

D. Status of Amendments

Subsequent to the November 14, 2002 Final Rejection, a first Amendment Under 37 C.F.R. 1.116 was filed February 14, 2003, which was denied entry by the March 14, 2003, Advisory Action. A second Amendment Under 37 C.F.R. 1.116 was filed May 14, 2003, which has not yet been entered. The Examiner did, however, orally indicate that the Amendment would be entered as no new issues were raised. This brief assumes that the Amendment is entered. Should the Amendment be denied entry, the arguments made therein relating to claim 60 would relate to claim 91.

Four Requests for Approval of Drawing Corrections have been submitted, two of which have been accepted and two of which have been denied. For purposes of clarification, all of the proposed drawing corrections are attached as Section IX, along with the drawings from Canadian application no. 2,256,944, which was incorporated by reference into this application at the time of filing.

II. SUMMARY OF THE INVENTION

This application claims a snowmobile having a revolutionary design that deviates from conventional ergonomic snowmobile standards. The claimed parameters represent a snowmobile that completely redefines the manner in which a rider is positioned on the vehicle. In this novel arrangement, the heaviest component of the snowmobile – which is the driver – is moved forward, while the engine is moved rearward. The result is considerably

---

<sup>1</sup> The final rejection erroneously includes claim 76, which was canceled in the Amendment filed September 24, 2001.

improved handling and ride, especially over rough terrain. (Page 1, lines 29-31; page 8, lines 29-31.)

This arrangement of components forces the rider into a dramatically different posture as compared to the conventional upright posture with the rider's feet in a forward inclined position and knees close to the steering device. (Fig. 1; Page 8, lines 17 - 23.) In this invention, the steering position is displaced forward of the center of gravity of the vehicle – this pulls the rider forward. (Fig. 2; Page 11, lines 7-8.) The steering shaft axis is repositioned at a more steep slope – this improves the steerability of the snowmobile by applying the steering force more directly. (Page 13, lines 10 – 19. ) Further, the rider's knees are located clear of the steering device. (Page 14, lines 7 – 15.) The steering device is positioned forward of the footrests – this results in moving the center of gravity of the rider closer to the center of gravity of the vehicle. (Page 14, lines 16 – 22.) The seat is positioned closer to the center of gravity and the footrests are positioned at a decline – this allows the rider to raise himself from the seat using his legs rather than his arms, thereby providing greater vehicle control. This also minimizes the forces transferred from the terrain to the rider by shortening the moment arm to the rider. (Page 11, lines 8 – 26.) Further, the rider is positioned by the seat and footrests so that his head is shielded from the wind by the windshield and so that he has a wider view of the ground in front of the vehicle. (Page 13, lines 20 – 30.)

The invention disclosed in this application is described in terms and parameters commonly used by the people who possess an ordinary level of skill in the pertinent art, including designers (such as engineers and technicians) that have experience in designing snowmobiles. The design of snowmobiles is based on ergonomic factors, which encompass those factors that allow a snowmobile to be operated by a rider. Such factors must

necessarily account for a rider since a snowmobile must be able to carry a rider in a position that allows the rider to drive the vehicle. The “rider” then becomes a design tool – an object that the snowmobile must accommodate, and the components must be positioned in relation thereto. As all riders vary, a “standard rider” 126 is described in this application to be used as the design tool to position the components of the vehicle 110. The “standard rider” 126 for purposes of this design possesses measurements based on a 50 percentile U.S. human male. (Page 9, lines 11-16.) This type of standard is common in the art of snowmobile design. The “standard rider” is, in actuality, a series of measurements used during computer aided design, as would be readily recognized by one possessing ordinary skill in the art of designing snowmobiles. If one was to construct a physical representation of a standard rider it might look like a crash test dummy.

Each claim is summarized and its support in the specification identified in Section VIII, Appendix B, attached hereto.

### III. ISSUES

(1) Does Japanese published patent application no 2-274,681 (hereinafter JPP ‘681) show each and every feature, and therefore anticipate, claim 73 under 35 U.S.C. §102(b)?

(2) Do claims 1-49, 55, 57-60, 64-68, 73, 77-90 and 92 contain subject matter that is not described in the specification in such a way so as to enable one skilled in the pertinent art to make and/or use the invention as required under 35 U.S.C. §112, first paragraph, because the specification fails to show an operative embodiment of the invention?

(3) Do claims 60, 73, 85, 88, 89, and 92 contain subject matter that was not described in the specification in such a way so as to reasonably convey to one skilled in the pertinent art that the inventors had possession of the claimed invention at the time the

application was filed as required under 35 U.S.C. §112, first paragraph, because of the recitation of the term “tunnel” and the position of the toe holds?

(4) Are claims 1-49, 55, 57, 64-68, 77-84, 87 and 90 indefinite for failing to particularly point out and distinctly claim the subject matter that Appellants regard as their invention as required under 35 U.S.C. §112, second paragraph, because of the use of the term “standard rider” or a “standard position” of a standard rider?

#### IV. GROUPING OF CLAIMS

Each claim of this patent application is separately patentable and upon issuance of a patent will be entitled to a separate presumption of validity under 35 U.S.C. §282. For convenience in handling of this Appeal, the claims are grouped as follows according to the issues in Part III:

A. Grouping of Claims for Rejection Under 35 U.S.C. §102(b)

1. Claim 73

B. Grouping for the Rejection Under 35 U.S.C. §112, First Paragraph – Enablement

1. Claims 1-49, 59, 60, 64-68, 73, 77-88, and 90

2. Claims 55, 57 and 58

3. Claim 92

C. Grouping of Claims for the Rejection Under 35 U.S.C. §112, First Paragraph – Written Description

1. Claim 73

2. Claim 85

3. Claim 88

4. Claim 60 (previously claim 91)

5. Claim 92

D. Grouping of Claims for the Rejection Under 35 U.S.C. §112,



Second Paragraph

1. Claims 1-39, 64-68, 77-80 and 87
2. Claims 40-49, 81, 82, 83, 88
3. Claims 55 and 57
4. Claim 58
5. Claim 84
6. Claim 90

The groups do not stand or fall together. In addition, the claims within each Group do not stand or fall together and are argued separately in the following arguments.

V. ARGUMENT

A. Claim 73 Is Not Anticipated by Japanese Patent Publication No. 2-274,681

Claim 73 stands rejected under 35 U.S.C. §102(b) over Japanese patent publication no. 2-274,681 (JPP '681). The November 14, 2002, Final Rejection states that JPP '681 shows a snowmobile with sideboards for a rider's feet that are angled at approximately 6° from horizontal and that the wall of the cowling provides a toe hold that prevents the rider's foot from sliding forward. The March 14, 2003, Advisory Action further states that the Examiner is relying on the drawings in JPP '681 for the relative angles between elements of the vehicle and the ground, although the specification is silent on this issue. This rejection should be reversed for the following reasons.

Claim 73 is directed to a snowmobile comprising, *inter alia*, a frame, a seat, and right and left sideboards extending laterally from the frame below the seat on either side thereof. Each of the sideboards has a forward portion suitable for placement of a rider's foot thereon, and the forward portion of each sideboard is disposed at an angle  $\Delta$  with horizontal that is -5°

to -10°. Right and left toe-holds are disposed respectively above the rider's toes in a vertical plane for allowing the rider to releasably secure himself to the snowmobile.

JPP '681 simply does not disclose sideboards at the claimed angle  $\Delta$  of -5° to -10°. The reference is silent as to any angle of the footrest, the disclosure being directed to a storage compartment and the heating of the footrest area to comfort the rider and melt snow on the footrest area. This is supported by the translation of JPP '681 that was provided to the Examiner with the February 14, 2003, Amendment.

Despite the assertion by the Examiner that the sideboards are angled at approximately 6 degrees from horizontal, it is well established that it is impermissible to base a rejection on a value measured from the drawings by the Examiner, absent a statement that the drawings are drawn to scale. See MPEP §2125, which states that "[w]hen the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. "[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.").

There is no statement in JPP '681 that the drawings are to scale. Also, the reference is silent as to the angle. The relative angles between the components shown in JPP '681 would not reasonably teach one of ordinary skill in the art to design sideboards at an angle to horizontal that is -5° to -10°.

In addition, JPP '681 does not disclose left and right toe holds ... for allowing the rider to releasably secure himself to the snowmobile. JPP '681 discloses nothing for allowing the rider to releasably secure himself to the snowmobile and no components are positioned above where a rider's toes would be located on the sideboards. The front surface of the foot rest

does not constitute a “toe-hold,” according to its well known meaning in the art, and is not above the sideboards.

Claim 73 effectively recites the combination of footrests negatively inclined at  $-5^{\circ}$  to  $-10^{\circ}$  at the forward portion of the sideboards with toe-holds provided above the sideboards. JPP ‘681 does not teach this arrangement. Accordingly, as each and every feature of claim 73 is not disclosed in JPP ‘681, reversal of the rejection of claim 73 under 35 U.S.C. §102(b) is respectfully requested. Claim 73 should be allowed.

B. The Specification Shows an Operative Embodiment, Is Fully Enabling, and Adequately Supports Claims 1-49, 55, 57-60<sup>2</sup>, 64-68, 73, 77-90 and 92 as Required By 35 U.S.C. §112, First Paragraph

The Final Rejection states that the positioning of the handlebars in Figures 2 and 3 would not allow any significant steering of the vehicle and that renders the invention inoperative. The Examiner states that Appellants are relying on an existing snowmobile configuration for elements of a working snowmobile with several changes, one of which is changing the position of the steering member. The Examiner believes that changing the position of the steering member would cause the steering member to but up against the windshield thus rendering the vehicle inoperative. As such, according to the Examiner, the specification does not provide an enabling disclosure. Appellants assert that the disclosure is enabling and that the disclosed embodiment is operative. Furthermore, the Appellants believe that the rejection is improper for the following reasons.<sup>3</sup>

---

<sup>2</sup> Claim 61 was canceled in the Amendment After Final Rejection and claim 60 was amended to be claim 91 in independent form. Claim 76 was canceled prior to the Final Rejection.

<sup>3</sup> It is noteworthy that the Examiner’s previous Supervisor (Supervisory Primary Examiner Brian Johnson) and Quality Assurance Examiner David Mitchell, at Appellants’ request, met with each other to discuss this and other rejections. Mr. Mitchell, a previous examiner in the snowmobile art, agreed that the rejection under § 112(1) was improper. Thus, it is unclear why this rejection is being maintained.

1. The Rejection Should Be Limited to Only Claims that Recite the Combination of the Windshield and the Steering Member as It Is Based on the Mistaken Belief that these Components Cannot Operate Together

This rejection is directed to claims 1-49, 55, 57-60, 64-68, 73, 77-90 and 92. Of these claims, only claims 55, 57, and 58 recite a steering device and a windshield. The remaining claims do not recite a windshield at all. Therefore, any issue with respect to the windshield and whether the description of the windshield adequately supports the claims should be limited to the claims that actually recite a windshield. The windshield description is irrelevant to claims that do not recite a windshield. Thus, it is requested that at the least, claims 1-49, 59, 60, 64-68, 73, 77-90, and 92 be withdrawn from this rejection.

2. The Specification as Filed Discloses a Fully Operative Embodiment

The Examiner maintains that positioning a steering device of a snowmobile forward of the seat and a windshield forward of the steering device, as recited in claim 55 and dependent claim 57, or positioning a steering device of a snowmobile forward of the seat and a windshield forward of the seat, as recited in claim 58, is based on an inoperative embodiment in the specification and that one of ordinary skilled in the pertinent art could not make and use the claimed invention based on the specification.

An analysis of whether a particular claim is supported by the disclosure in an application requires a determination as to whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims to enable one skilled in the pertinent art to make and use the claimed invention. The standard to be applied is whether experimentation needed to practice the invention is undue or unreasonable. (MPEP §2164.01)

This application as filed includes a detailed description of the steering device 132, a steering position 136 and a steering shaft 162. The steering device 132 is described as being

a handlebar or any suitable steering device, such as a yoke or steering wheel. (Page 9, lines 22 – page 10, line 2.) There is a discussion of how this invention positions the steering shaft 162 at an angular position, which facilitates placement of the steering position 136 in a position forward of that for a conventional snowmobile. (Page 13, lines 10 – 19.)

The windshield 124 is first introduced on page 9, lines 1 and 2, and is described as extending upwardly from fairings 122 to act as a windscreen for rider 126. On page 13, lines 20 – 26, the laminar flow characteristics created by the windshield 124 in combination with the novel rider position are described. Figs. 2 and 3 show the windshield 124 and the steering device 132 in a side view while Fig. 4 shows a top view of the steering device 132 with the windshield removed. Fig. 4 shows that the steering device 132 actually moves, which illustrates that the steering device 132 operates. The Examiner's objection is based on the schematic depiction of the windshield 124, which is shown in Fig. 2 as being in close proximity with the steering device 132. Appellants assert that this objection is unfounded.

First, one of ordinary skill in the art of designing snowmobiles would readily recognize that the drawings are schematic in nature. Even if experimentation were necessary or desirable to position the windshield with respect to the steering device to allow the steering device to turn to a greater degree, such experimentation would not be undue, and it is well settled that the test of enablement is not whether any experimentation is required, but whether the experimentation is undue.

Appellants submit that a snowmobile designer would recognize that, in an actual vehicle outfitted for use, the windshield could be slightly more spaced from the steering device than shown in the schematic depiction of Fig. 2 to be fully operational. Alternatively, the windshield could be connected to the steering mechanism to turn with the steering mechanism, which is a well known snowmobile design. See for example, U.S. Patent

5,129,473 and U.S. Patent 5,152,365, both of which show this conventional arrangement.

(Copies attached in Section X.)

Taking into account factors that must be considered to determine enablement such as, but not limited to, the breadth of the claims, the nature of the invention, the state of the prior art, the level of one of ordinary skill in the art, the level of predictability in the art, and the quantity of experimentation needed to make or use the invention based on the content of the disclosure as a whole, it is reasonable to conclude that there is considerable guidance in the specification and in the known prior art to determine a satisfactory placement of the windshield with respect to the steering device to allow the vehicle to operate without requiring undue experimentation. (MPEP §2164.01(a)) A snowmobile designer would readily recognize that the vehicle would operate as disclosed without undue experimentation.

Second, the determination of enablement must be based on the evidence as a whole. It is improper to seize on one portion of the disclosure to determine a lack of enablement when the disclosure as a whole clearly explains an operable invention. There is no requirement in the patent laws or rules that the drawings of the invention be detailed engineering drawings with precise, to-scale measurements. Instead, the drawings are meant to be exemplary of the teachings of the present disclosure.

In addition, Applicants may submit factual affidavits under 37 C.F.R. §1.132 or submit references to show what one skilled in the art knew at the time of filing the application. Such a declaration is evidence that must be considered in making a determination regarding enablement. (MPEP §2164.05) The §132 Declaration of Robert Handfield filed July 9, 2002, includes information that should be considered in relation to the rejection set forth under 35 U.S.C. §112, first paragraph. In particular, paragraphs 47 and 48 of the Declaration explain how the drawings originally filed with the application were schematic in nature, but that one of ordinary skill in the art, such as Mr. Handfield, would

have understood how to make a fully operational and steerable snowmobile according to what is described in the present specification and shown in the original drawings. The Declaration clearly provides evidence that one of ordinary skill in the art would not have to conduct undue experimentation to make a vehicle based on this disclosure that can be steered.

Finally, in an effort to satisfy the Examiner's objections to the windshield, a number of drawing corrections have been proposed during prosecution. This application claims priority to and incorporates by reference a Canadian application no. 2,256,944. Reviewing this document shows that Fig. 4, which comports to the Canadian Fig. 9,<sup>4</sup> omits the windshield spaced from the steering device that is clearly shown in the Canadian Fig. 9. Appellants have tried to change the drawing to correspond to the Canadian Fig. 9 (which is part of the original disclosure by virtue of being incorporated by reference into this specification upon filing), but such change has been denied by the Examiner. Amendments to an application that are supported by the original description are not new matter, and an amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of the error in the specification, but also the appropriate correction. (MPEP §2163.07, citing *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).) Although an applicant may not rely on a foreign priority document to support correction of an error, this does not apply where the U.S. application explicitly incorporates the foreign priority document by reference, as in this case. Thus, there is no legal basis for denying Appellants the opportunity to correct Fig. 2.

Appellants believe that the specification is completely enabling and complies with the requirements of 35 U.S.C. §112, first paragraph, as it presently stands. Constructing an operative embodiment by spacing the windshield slightly more from the steering device than shown in Fig. 4 or connecting the windshield to move with the steering device would be well

---

<sup>4</sup>

Also attached in Section IX.

known to those of ordinary skill in the snowmobile art and would not require undue experimentation. Nevertheless, the Examiner has maintained this rejection and objection to the drawings, so Appellants would prefer to make the change to the drawing. Appellants therefore request that the Board authorize entry of the drawing correction requested on May 22, 2002, or February 14, 2003.

Reversal of the rejection of claims 1-49, 55, 57-59, 60, 64-68, 73, 77-90 and 92 under 35 U.S.C. §112, first paragraph, for not providing an enabling disclosure supportive of these claims is respectfully requested. Also, approval of the drawing corrections filed either May 22, 2002, or preferably the drawing corrections filed February 14, 2003, is respectfully requested.

- C. The Specification Describes the Tunnel and Toe-Holds in Such a Way as to Convey that the Inventors Had Possession of the Subject Matter of Claims 60, 73, 85, 88, and 89 in Accordance with 35 U.S.C. §112, First Paragraph

The Examiner argues that the inventors did not have “possession” of the claimed invention at the time the application was filed in regard to (1) a tunnel (claims 85, 88, 91 (now claim 60) and 92) or (2) toe-holds in a vertical plane above the rider’s toe (claim 73). The Examiner further asserts that the introduction of the term “tunnel” is new matter and requires its cancellation.

For the inventors to have “possession” of the claimed invention, all that is required is that Appellants show some basis in the text or drawings for the tunnel and toe-hold features. As explained below, the original specification (page 10, first full paragraph) provides support for the claimed toe-holds, and the original application (Figures 5-18) shows and describes the claimed tunnel.



1. The Tunnel Is Shown in Original Figures 5-18

The Examiner asserts that the “tunnel” recited in claims 85, 88, 60, and 92 and its relationship to other structure on the vehicle is not supported by the original disclosure. The Examiner declares the term “tunnel” new matter.

The issue regarding an adequate written description is whether the specification describes the claimed invention in sufficient detail so that one skilled in the art can reasonably conclude that the inventors had possession of the claimed invention. Each claim limitation must be expressly, implicitly, or inherently supported by the originally filed disclosure. The mere rephrasing of a passage does not constitute new matter. (MPEP §2163.07(I).) Moreover, there is no requirement that words in a claim must match exactly those used in the specification (MPEP §2173.05(e).)

First, although the term “tunnel” did not appear in the specification as filed, it does appear in the Canadian priority application, which was incorporated by reference into this application upon filing<sup>5</sup>. See Canadian application no. 2,256,944: Figures 10-13, 16, 20, 21 and 22; page 3 (“the rear of the main frame is the standard unibody frame with a tunnel therein”); page 9 (“a tunnel area (27) is shown”); and claim 2 (“the rear chassis including a tunnel”). The tunnel in the Canadian application clearly corresponds to that portion of the frame shown in original Figures 5-18 of the present application. So, the term was effectively present upon filing. In view of this, the rejection should be withdrawn.

Second, the term “tunnel” is implicitly and/or inherently supported by the originally filed disclosure. Figures 5-18 show the tunnel, which is part of the frame. For clarity, the specification (which previously only referred to the frame in general) was amended to make reference to the tunnel to describe, in terms well known and common to the snowmobile art,

---

<sup>5</sup> Appellant has tried to amend the specification to include the subject matter incorporated by reference but has been denied by the Examiner. See the March 14, 2003, Advisory Action.

what is shown in these drawings. (See the May 22, 2002, Amendment to page 9 of the specification, which adds: "Figs. 5-18 show that portion of the frame 114 that is commonly referred to in the snowmobile art as a tunnel.") Appellants are not attempting to redefine the frame, but merely to use a common and accepted term of art. Everyone skilled in the art of snowmobile design recognizes the term tunnel. In fact, many patents use this term in describing snowmobile frames. See, for example, U.S. Patent 5,129,473 assigned to Appellants' competitor Yamaha, which states in col. 4, lines 3-5, "...the U-shaped main frame member 12 directly below the seat 20 in a zone commonly referred to as the 'tunnel'." See also U.S. Patent 5,692,579 assigned to Appellants' competitor Polaris, which states in col. 3, lines 22-23, "...the snowmobile frame or chassis (often referred to as the 'tunnel')."

Accordingly, Appellants respectfully submit that the positional relationship between the tunnel and other structure on the vehicle is supported by the original disclosure and is well known to those skilled in the pertinent art. Appellants request that the rejection under 35 U.S.C. §112, first paragraph, of claims 85, 88, 60, and 92 be reversed.

## 2. The Toe-Holds Are Supported in the Original Disclosure

The Examiner states that the position of the toe-holds in a vertical plane above the rider's toe is new matter, not specifically disclosed or shown in the original drawings. The Examiner asserts that as the specification only refers to toe holds with no structural detail, the drawings, even including the approved drawing changes, cannot be relied upon to support this claim feature.

As explained above, the issue regarding an adequate written description is whether the specification describes the claimed invention in sufficient detail so that one skilled in the art can reasonably conclude that the inventors had possession of the claimed invention. In this application, the inventors described the toe-holds in detail commensurate with the claims, thereby demonstrating that they possessed the inventive feature relating to the toe-holds.

The disclosure provides the following support. The specification points out that, under normal operating conditions, the rider's feet 146 will rest on a forward portion of the sideboards. Preferably, toe-holds 145 are disposed above these forward portions and permit the rider to releasably secure himself to the vehicle. (See page 10, lines 6-7 of the original specification.) As toe-holds 145 are above the forward portions of the sideboards, which is where the rider's toes are located, it is clear that the toe-holds are positioned in a vertical plane above the rider's toes. It would be reasonable for one skilled in the art to conclude that if the toe-holds are above the sideboards where the rider's feet are positioned they would be disposed respectively above the rider's toes in a vertical plane for allowing the rider to releasably secure himself to the snowmobile, which is precisely what is recited in claim 73.

It is respectfully requested that the Board reverse the rejection of claim 73 under 35 U.S.C. §112, first paragraph, based on an inadequate written description.

D. The "Standard Rider" and the "Standard Position" Are Defined with Definite Parameters and Satisfy the Requirements of 35 U.S.C. §112, Second Paragraph

Claims 1-49, 55, 57, 58, 64-68, 77-84, 87 and 90<sup>6</sup> stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite due to the "recitation of the vehicle based on the position of the standard rider ... because it lacks a reasonable degree of certainty with respect to the structural features it is meant to describe. It forces a potential infringer to design and build his vehicle without knowing if it will infringe until testing using a standard rider." The Examiner further responds to rebuttals of this rejection stating that the vehicle is defined "based on a theoretical position that a particular rider would assume." This rejection is respectfully traversed for reasons set forth below.

---

<sup>6</sup> It appears that claim 88 should have been included in this rejection as it depends from claim 40, which is included in the rejection. It appears that the examiner intended to include claim 58 in the rejection as well, since it includes the terms "standard rider" and "standard position". Clarification in the Examiner's Answer or the next Office Action is respectfully requested. Appellants note that the Examiner was notified as to this apparent error in the February 14, 2003, Amendment, but the Examiner has chosen not to take any corrective action in this regard.

Appellants believe that there is a fundamental misunderstanding by the Examiner of term “standard rider” or “standard position” of a standard rider as used in this application. The standard rider as used herein is a design tool – a ruler in a sense – that represents a series of measurements used in positioning the components of the vehicle. These measurements are set forth in the specification. The confusion lies in the fact that the measurements are based, at least in part, on an average human body because the vehicle must be designed to accommodate a human rider to operate. The standard rider is a tool for use in designing the vehicle, as would be readily understood by one of ordinary skill in the art of designing snowmobiles. Such tools are typically used in computer assisted design, as is conventionally known and practiced.

Appellants are not trying to claim an actual rider or a person. This would be understood by those skilled in the design art, but apparently is misunderstood by the Examiner. The Final Rejection states that “the examiner maintains that a rider, a human being, cannot be standardized. Also, even if the rider could be standardized, the position of the rider on the cycle depends on more than simply the dimensions of the rider. The stiffness of the joints, the comfortable posture, the energy level of the rider, and simple preferences of the rider factor into the positioning on the cycle.” The features noted by the Examiner pertain to human characteristics, which cannot be applied to Appellants’ mathematical construct. The claimed standard rider cannot have “preferences” as it is not a living being.

The measurements set forth in Appellants’ specification are the relevant factors in snowmobile design and placement of the snowmobile components. These measurements are provided in the specification in excruciating detail. Thus, the definition of the standard is clear and satisfies the requirements of 35 U.S.C. §112, second paragraph.

The essential inquiry pertaining to whether a claim meets the threshold requirements of clarity and precision must be analyzed in light of the content of the particular application

disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. (MPEP §2173.02.) It is asserted that the measurements that define the standard rider design tool and the standard riding position are clearly set forth, in great detail, in this specification. Further, it is well known in the prior art and by those of ordinary skill in the art of designing snowmobiles to use such design tools. Accordingly, these parameters define the invention with clarity and precision in a well known context.

As for the content of this application's disclosure, the details of the standard rider design tool used in this specification, which are the measurements that the standard rider is assigned, are clearly set forth with the intent that it would be clear what parameters the positions recited in the claims are based upon. As explained above, the standard rider dimensions are based on a 50 percentile U.S. male, the dimensions of which are provided with a large amount of detail in Figures 19 and 20. In fact, every conceivable dimension of the 50<sup>th</sup> percentile human being that would be useful to a snowmobile maker (or potential infringer) is provided in the specification. The standard position is also defined in detail in the specification.

As to the teachings of the prior art, there are numerous valid patents that define various vehicles in relationship to the invention's human riders, which illustrates that this is a commonly accepted parameter in the vehicle art. By way of example: U.S. Patent No. 5,355,826 defines a watercraft in terms of the rider's positioning on the vehicle; U.S. Pat. No. 3,913,929 recites in claim 1 "the center of gravity of said cycle with the rider in said rider support means, lies below said plane"; U.S. Pat. No. 5,908,078 recites in claim 1 "substantially parallel to the ground at the height of the center of gravity of the vehicle and rider assembly"; U.S. Pat. No. 6,109,633 recites in claim 14 "a tube extending above the center of gravity of the bicycle and rider"; U.S. Pat. No. 5,577,750 recites in claim 1 "having

a combined center of gravity when mounted by a bicycle rider...such that said pole mounting means is located near said combined center of gravity”; and, U.S. Pat. No. 4,893,579 recites in claim 1 “said hull being configured such that said hull assumes a generally upwardly inclined position when riders are seated in tandem on said rear seat and said hull is traveling forwardly at speed and in a substantially horizontal condition when said watercraft is not traveling and riders of approximately equal weight are seated respectively on said forward and rear seats at approximately equal distances from said bridge.” (Copies of these patents are attached in Section X.)

The Examiner for this application has also issued at least 70-80 patents that define an apparatus (mostly land vehicles) in terms of a rider, a user, an operator or a person. For example, claim 1 of U.S. Patent No, 5,501,476 (the ‘476 patent) recites:

...means for receiving at least a portion of a user’s thigh at a position of the user’s leg between the user’s knee and the user’s hip, the means comprising...means for receiving the back of the user’s thigh such that contact with the back of the user’s thigh is made and the means for receiving the back of the user’s thigh is moved by the hip extension motion of the user...”

It has already been discussed above that using parameters based on human measurements is a common, and even necessary tool, in the art of ergonomic design, particularly for vehicles that carry a rider. As such, one of ordinary skill in the art of designing snowmobiles would recognize and understand the disputed claim terms.

It is further noted, that the courts support this view. In *Banyan Licensing L.C. v. Allied Foam & Packing*, 2000 WL 1671797 (N.D. Ohio, 2000) , the court upheld validity of a claim under 35 U.S.C. §112 for a claim drawn to a pillow having a longitudinal axis "no less [in length] than that of a human thigh.” In the case of *Ex parte Brummer*, 12 USPQ2d 1653, 1655 (Bd. App. 1989), the Board considered a claim directed to a bicycle in which the bike’s wheel base was defined as a function of a height of the rider that the bicycle was designed for. The Board affirmed the Examiner’s rejection based on indefiniteness (under 35 U.S.C.

§112, second paragraph) because there was no evidence that there was a known standard in the field of bicycle manufacturing for sizing a bicycle to a rider. In distinction, in this application, Appellants have provided a standard (the 50 percentile human U.S. male) along with precise measurements.

Each of the independent claims sets forth the standard rider (or standard load (claim 84)) and/or the standard riding position in varying degrees, using plain language that would be readily understood by one of ordinary skill in the art (reading the claims as a whole, not in a vacuum). Appellants note that each claim uses the standard rider or standard riding position as a tool to define the positions of different components on the vehicle. As such, the claims should stand on their own merits despite the use of some common terminology.

Finally, it is noted that claim 84 does not refer to a standard rider, but rather a standard "load". As such, claim 84 should not be included in this rejection. The rejection of claim 84 should be vacated.

Reversal of the rejection under 35 U.S.C. §112, second paragraph, is respectfully requested.

VI. CONCLUSION

For the above reasons, Appellants respectfully request this Honorable Board to reverse all of the rejections of the claims. All of the claims are in condition for allowance.

Respectfully submitted,

PILLSBURY WINTHROP LLP



Caroline D. Dennison  
Reg. No. 34,494

Jeffrey D. Karceski  
Reg. No. 35914

Paul T. Bowen  
Reg. No. 38,009

CDD/JDK/tam

U.S. Application No. 09/472,134

P.O. Box 10500  
McLean, Virginia 22102  
Tel.: (703) 905-2000  
Fax: (703) 905-2500